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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,720	03/19/2004	Mark E. Kirby	1051.09	2719
21901	7590	11/29/2005	EXAMINER	
SMITH & HOPEN PA 15950 BAY VISTA DRIVE SUITE 220 CLEARWATER, FL 33760			CHAN, SING P	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,720

Applicant(s)

KIRBY, MARK E.

Examiner

Sing P. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ° 1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a method of installing tiles on a vertical support surface, classified in class 156, subclass 71.
 - II. Claims 9-16, drawn to a tool for tile installation, classified in class 81, subclass 484.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as a level for leveling brick for building brick wall.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for Group I is not required for Group II, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Ronald E. Smith on October 4, 2005 a provisional election was made without traverse to prosecute the invention of group I,

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claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-16 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation "rotating said device against said vertical support surface until said tile support surface is coincident with said elongate level marker" is not described in the specification.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 5,263,260) in view of Hannay (U.S. 1,836,846) and admitted prior art.

Regarding claims 1-4, Smith discloses a method of installing ceramic chair rail or tiles. The method includes providing an elongated support member with a tile support surface, selecting a height, i.e. marking on a surface, on a wall, positioning the support member on the selected height, which is in abutting and overlaying position over the wall or vertical surface, leveling the support member, i.e. rotating the support member, using spirit level, inserting push pins into each of the pin holes to maintain the support surface or edge at an attitude perpendicular to the wall, laying the ceramic chair rail or tiles along the edge of the support member, and after the tiles are set, removing the support member. (Col 6, line 66 to Col 7, line 14) Smith is silent as to the pin holes are elongated and axially misaligned with respect to one another to maintain structural integrity and making an elongate level marker on the wall. However, providing elongated holes for pin and axially misaligning with respect to one another is well known and conventional as shown for example by Hannay. Hannay discloses a method of forming plaster trim. The method includes providing a removable plaster trim form with two long side plates formed of sheet metal with nail holes to receive nail (Page 1, lines 68-83) and nail slots are provided on the overlapping plates to permit extension of the two plates from each other. (Page 2, 18-29)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide nail slots along the plates of the support member as disclosed by Hannay in the method of Smith to allow the extension of the support

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members. (See Hannay, Page 2, lines 23-29) Smith as modified by Hannay is silent as to making an elongate level marker on the wall. However, making an elongate level marker on the wall is well known and conventional as shown for example by the admitted prior art. The admitted prior art discloses the first step of applying tile to the wall is to draw a level pencil line using ruler and a water level or laser level. (See Specification, Page 10, lines 1-7)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an elongate level marker on the wall as disclosed by the admitted prior in the method of Smith as modified by Hannay to form a level line at uniform height and avoid making uneven line on the wall by making a plurality of measurements from floor, which may be warped. (See Specification, Page 2, lines 6-10)

Regarding claim 6, Smith discloses the support member includes a first and second predetermined depth with the second predetermined depth greater than the first predetermined depth with a base and support surface share a common flat back wall adapted to abuttingly engage the wall and the second predetermined depth is sized to approximately equal to a combined thickness of a tile and a layer of adhesive. (Col 5, lines 17-36 and Figure 6)

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 5,263,260) in view of Hannay (U.S. 1,836,846) and admitted prior art as applied to claim 1 above, and further in view of Sykes (U.S. 2,466,919).

Smith as modified above is silent as to the support member includes releasable couplers. However, providing releasable couplers for support member is well known and conventional as shown for example by Sykes. Sykes discloses a method of setting tiles. The method includes providing two tile templates with each of the template include a lug and the other end a recess for interengagement of the adjacent template. (Col 2, lines 21-33)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a lug and a recess on the template for tile setting as disclosed by Sykes in the method of Smith as modified by combination of references to allow interengagement of the adjacent template or support to allow for two tile setters to work side by side. (See Sykes, Col 2, lines 21-22)

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. 5,263,260) in view of Hannay (U.S. 1,836,846) and admitted prior art as applied to claim 1 above, and further in view of Keady (U.S. 5,761,876) and Masuda (U.S. 5,048,890).

Smith as modified above is silent as to the support member includes notches for bending to overlies a convex or concave wall. However, providing a support member for a curved wall is well known and conventional as shown for example by Keady. Keady discloses a method of forming a stone wall with a curve. The method includes providing staves to support and bond any object such as bricks, cinder blocks, clay blocks or stones (Col 1, lines 9-12, Col 2, lines 30-34, and Col 3, lines 50-55), bending

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the staves to conform to the curved wall and attaching to the front guide (Col 3, lines 7-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide staves and bending the staves to conformed to the curved wall to help support the object to be bonded to the wall as disclosed by Keady in the method of Smith as modified by combination of references to provide an upright support for object be bonded and prevent the object from falling onto workers during the process. (See Keady, Col 1, lines 9-16) Smith as modified by the combination of references is silent as to providing notches to bend the support member. However, providing notches to bend a member is well known and conventional as shown for example by Masuda. Masuda discloses method of forming a guide rail. The method includes forming notches in the rail and then bending in a curved wall jig. (Col 4, lines 10-22)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide notches in the member prior to bending as disclosed by Masuda in the method of Smith as modified by the combination of references to allow the bending of the member without longitudinal elongation on the outer peripheral side. (See Masuda, Col 3, lines 2-16)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan Sung Po

SPC

ca fiorilla

CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER

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